

REMARKS/ARGUMENTS

Claims 61-64, 67, 68, 70-84 and 86-99 are pending in the application. Independent claims 61, 78, and 90 have been amended to recite additional characteristics of the capsule, such as noting that the payload is an anhydrous liquid or gel comprising a flavoring agent and a diluting agent. Claim 65 has been cancelled without prejudice or disclaimer in light of the amendment to claim 61, and claims 76, 82, and 88 have been amended to retain consistency with the amended independent claims. Support for the amendments can be found throughout the specification, such as on pages 21-24 and in Example 1, where use of a capsule comprising an anhydrous triglyceride carrier and an essential oil is described. Applicants respectfully submit that no new matter is introduced by these amendments.

Claims 61-64, 67, 70-75, 77-81, 83, 84, 86, 87, and 89-99 stand rejected under 35 U.S.C. §103(a) as unpatentable over the combination of Berger (US 4,046,063), Dorsey (US 5,549,124), and Homburger (US 3,297,038). In addition, Claims 65, 76, 77, 82, 88, 89, and 92-95 stand rejected over the above noted combination of references, further in view of Irby, Jr. (US 3,390,686). In both rejections, the Examiner relies upon the Dorsey and Homburger references as motivating the inclusion of a breakable capsule in the filter configuration of Berger. Applicants respectfully traverse these rejections.

To establish a *prima facie* case of obviousness, according to a test predominately used by the courts, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim elements. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

With regard to the Supreme Court's decision in *KSR Int'l. Co. v. Teleflex, Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007), it is noted that the Court did not dismiss the usefulness the well-

established “teaching, suggestion, or motivation” test set forth above, but merely cautioned against its rigid application. The Supreme Court in *KSR* commented that the Federal Circuit “no doubt has applied the test in accord with these principles [set forth in *KSR*] in many cases.” *Id.* at ___, 82 USPQ2d at 1396. However, the Supreme Court also opined that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results. . .” *Id.* at ___, 82 USPQ2d at 1395-96. Regardless of the precise test used, the Court, quoting *In re Kahn*, cautioned that “ ‘[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.’ ” *Id.* at ___, 82 USPQ2d at 1396.

Applicants respectfully submit that the cited art fails to teach or suggest the claims as originally presented prior to this amendment. However, in order to expedite prosecution, Applicants have modified the claims to clarify preferred aspects of the breakable capsule claimed herein.

In particular, all claims of record now recite that the payload of the capsules is an anhydrous liquid or gel comprising a flavoring agent and a diluting agent. This is clearly not taught in either of the two cited references relied upon by the Examiner as suggesting capsules within a filter. The Homburger patent relates to capsules containing a granular material such as activated charcoal. There is no suggestion in Homburger to fill a capsule with a liquid or gel composition as presently claimed. In addition, the Dorsey patent fails to teach or suggest an anhydrous liquid or gel composition within a filter. Instead, the Dorsey patent repeatedly refers to the capsule as containing water. See title, abstract, and both paragraphs in column 1.

It is also noted that there would be no motivation to alter the contents of the capsules of Homburger or Dorsey in order to arrive at the claimed invention, because to do so would clearly render the capsules unsuitable for their intended purpose. The purpose of the Homburger capsule is to expose smoke to a granular activated carbon material. The purpose of the Dorsey capsule is to wet tobacco with water. Both of these purposes would be frustrated by use of an internal payload in the form of an anhydrous liquid or gel.

It is also noted that the cited Irby, Jr. patent fails to teach or suggest a capsule comprising the claimed internal payload and also fails to teach or suggest use of such a capsule within a cavity as presently claimed. There is nothing in the Irby, Jr. patent suggesting the use of an anhydrous liquid or gel composition within a capsule that comprises both a flavoring agent and a diluting agent that is not water. Instead, Irby, Jr. focuses on the use of water as the treating liquid and also teaches payload embodiments comprising solid adsorbents in slurry form.

The independent claims also contain additional patentable distinctions over the cited art. For example, claim 61 recites the presence of a triglyceride diluting agent in the anhydrous composition. There is nothing in the cited art to suggest an anhydrous composition comprising a flavoring agent and a triglyceride diluting agent. In addition, claim 78 recites that the flavoring agent is present in an amount of about 5 to about 25 weight percent, with the balance of the anhydrous composition being the diluting agent. There is nothing in the cited art to teach or suggest such a composition. Still further, claim 90 recites that the force required to break the capsule is in the range of 1000 to 2500 g. The cited art is silent as to the desired crush strength of the capsules. For at least the reasons presented above, Applicants respectfully request reconsideration and withdrawal of these rejections.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

/christopher m. humphrey/

Christopher M. Humphrey
Registration No. 43,683

Appl. No.: 10/600,712
Amdt. dated November 10, 2009
Reply to Office Action of June 10, 2009

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Raleigh Office (919) 862-2200
Fax Raleigh Office (919) 862-2260

ELECTRONICALLY FILED USING THE EFS-WEB ELECTRONIC FILING SYSTEM OF THE UNITED STATES PATENT &
TRADEMARK OFFICE ON NOVEMBER 10, 2009.